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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/692,621	10/24/2003	Eugene A. Mirkin	CS23258RL	8789
20280	7590	01/14/2005	EXAMINER	
MOTOROLA INC			JACKSON, BLANE J	
600 NORTH US HIGHWAY 45			ART UNIT	
ROOM AS437			PAPER NUMBER	
LIBERTYVILLE, IL 60048-5343			2685	

DATE MAILED: 01/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/692,621

Applicant(s)

MIRKIN ET AL.

Examiner

Blane J Jackson

Art Unit

2685

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 October 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,4, 6-9, 11,12,14,15,17 is/are rejected.
- 7) ☒ Claim(s) 2,5,10,13 and 16 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 October 2003 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>10/03</u> .   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 3, 4, 6-9, 11, 12, 14, 15 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kraft et al. (U.S. Patent Application Publication 2003/0104839 A1) with a view to Hastrup (U.S. Patent 6,223,059).

As to claims 1, 3, 9 and 14, Kraft teaches a method and a wireless communication device for performing full string evaluation of words comprising:

Receiving data input corresponding to at least one compound word (key stroke sequence into a mobile telephone including a display, processor and keypad, figures 1-4, paragraphs 21-27),

Identifying word combination of shorter words that may be combined to form at least a portion of the at least one compound word (using a predictive editor supported by a word completion dictionary, paragraphs 33-37, where the editor selects combinations to complete the word),

Prioritizing word combinations based on at least one criteria, the at least one criteria including distinguishing word combinations having a particular total quantity of shorter words from word combination having a different total quantity of shorter words

(words within words or additional characters are considered by the predicting editor based on the word completion dictionary, paragraph 42, prioritization of the presented word from the completion dictionary including frequency of use, paragraph 48, the shortest or the first found, paragraphs 62-66).

Although Kraft teaches a predictive editor application with a word completion feature, he does not specifically teach a direct awareness of predictive editing for performing full string evaluation of (each word portions of) *compound words*.

Haestrup also teaches a communication terminal with a predictive editor application and user dictionary where the user, with character entry or word selection, may select or “freeze” the displayed portion or word portion of the intended complete compound word to signal the predictive editor to process the next/ last portion of the compound word, figures 1-4, column 9, line 45 to column 10, line 57).

It would have been obvious to one of ordinary skill in the art at the time of the invention to recognize in the predictive editor and word completion dictionary of Kraft the identification of a word portion of a compound word as taught by Haestrup for efficient text entry by the user of the terminal device.

As to claims 4, 6, 8, 15 and 17, Kraft teaches scoring each word combination based on probability of occurrence (character entry application sorts or prioritizes the matches including latest use and most frequently used is essentially scoring for a displayed match for selection by the user, paragraph 48).

As to claim 7, Haestrup of Kraft modified teaches identifying word combinations of shorter words includes identifying all character combinations that may correspond to the data input (predictive editor recognizes the beginning of a new word at the end of an existing word, column 8, lines 23-27).

As to claim 11, Kraft teaches a transceiver coupled to the processor configured to transmit a message that includes at least one compound word identified by the processor (a communication terminal with a word completion directory, paragraph 3).

As to claim 12, Kraft teaches the display shows one of either the word combination having the higher priority and a plurality of word combination in priority order (scroll between different matches, paragraphs 57-66, prioritized: paragraph 48).

### ***Allowable Subject Matter***

3. Claims 2, 5, 10, 13 and 16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Conclusion***

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kraft (U.S. Patent Application Publication 2003/0036411 A1) discloses a basic method of multi-tap text input by the user of a mobile terminal.

Koivuniemi (U.S. Patent Application Publication 2004/0177179 A1) discloses a text data input method in user terminals where the toggling between the multi-tap and predictive editor is automatic. Pugliese (U.S. Patent Application Publication 2003/0234821 A1) discloses a method for the prediction of a text message input. Rossman (U.S. Patent Application Publication 2002/0039899 A1) discloses a method for an interactive two-way data communication network where the cellular telephone includes a predictive data entry program to facilitate user data entry.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Blane J Jackson whose telephone number is (703) 305-5291. The examiner can normally be reached on Monday through Friday, 8:00 AM-5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Urban can be reached on (703) 305-4385. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number: 10/692,621  
Art Unit: 2685

Page 6

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